

Serial No.: 10/671,846
Amdt. Dated March 14, 2006
Reply to Office action of December 14, 2006

133074-1

REMARKS

In the Office Action mailed December 14, 2005 the Examiner rejected claims 1-13. Claims 14-28 were withdrawn pursuant to an earlier restriction requirement and election. The Applicants hereby request that claims 14-28 be cancelled and new claims 29-32 be added. The December 14, 2005 Office action has been carefully considered. The Applicants respectfully request reconsideration of the application by the Examiner in light of the above amendments and the following remarks.

35 USC § 102 Rejections

The Examiner rejected claims 1-13 under 35 U.S.C. § 102(b) as being anticipated by McGrath et al. (U.S. Patent 4,025,159; hereinafter called "McGrath").

Claim 1 of the present application recites a multilayer backlighting display optical film comprising at least two backlighting display component films and wherein at least one of the backlighting display component films has an upper and an essentially planar lower surface, the upper surface comprising a series of optical structures and a plurality of raised spacing structures which provide for a gap between the component films. Such backlighting display component films include but are not limited to diffusers, brightness enhancement films, and polarization recycling films. See for example, paragraphs [0002], [0003] and [0011] of the instant specification.

The Applicant's invention relates to the use of films having a particular recited structure as backlighting display films. The Applicants are not aware of any teaching in the prior art which would suggest the suitability of the films of the present invention for use as backlighting display optical films. The prior art cited by the Examiner (McGrath) discloses films which would be manifestly unsuited for use as backlighting display optical films. The Applicants are not at this stage asserting that the films they envision as useful as backlighting display films are structurally novel, although they may be, but merely that such films would be especially suitable for use as backlighting display optical films and that the discovery that such films may be used in backlighting display optical films represents a patentable discovery. That said, the Applicants must find suitable

Serial No.: 10/671,846

133074-1

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language with which to describe their invention. Where an invention depends on the nature of the use or work it is to perform, an adequate description of the claimed invention may require that the preamble of the claim describing the invention be read as a limitation on the claimed invention. The applicants urge that unless the claim preamble is read in such a way so that it limits their claim, they cannot adequately describe their invention. The Examiner has cited passages in the MPEP contrary to the Applicants' position. For example, the Examiner states, "[T]he preamble/limitation 'backlighting display' is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (MPEP § 2111.02)."

The Applicants respectfully submit that the Examiner's position is but one of several positions which might be taken consistent with the teachings of the MPEP. The Applicants hesitate to suggest that the Examiner's position is wrong, but do point out that the adoption of such a position works to deny the Applicants the fairest means of describing their invention in simple language. The following sections of MPEP § 2111.02 (8th ed., Rev. Oct. 2005) are relevant and may provide additional direction in resolving the question of how much weight to accord a claim's preamble:

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963)

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989)

"If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life,

Serial No.: 10/671,846

133074-1

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meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.).

The Applicants note that of the various passages from the MPEP and the caselaw undergirding the MPEP, the rule regarding the claim preamble being 'necessary to give life, meaning, and vitality' to their claimed invention is later in time.

In claim 1, the recitation "backlighting display" is indeed meant to highlight an intended use, but it is that intended use which comprises the very heart of the invention. Unless the claim is to be a mere recitation of structure, the preamble must be read to limit the claim to the use of the films described as "multilayer backlighting display optical films". The term "multilayer backlighting display optical films" undeniably gives life, meaning, and vitality to the claim. It is through the preamble that the subject matter of the present invention may be known. The recitation is essential to pointing out the very nature of the invention.

The present invention is directed to films and the use of these films for backlighting displays. McGrath does not teach or disclose films especially suited for backlighting for optical devices, such as liquid crystal displays, but instead, discloses retroreflecting sheeting designed to reflect all or a majority of light back towards the light source. The retroreflective sheeting disclosed by McGrath, cannot be used as a backlighting display optical film. To serve their respective intended uses, retroreflective sheeting and backlighting display optical films manage and direct light differently as a

Serial No.: 10/671,846
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133074-1

direct consequence of their structural differences. Because McGrath neither discloses films suitable for use as backlighting display component films nor the use of any film as a multilayer backlighting display optical film, McGrath cannot be fairly read to anticipate the Applicants' claimed invention. The Applicants thus respectfully request that rejection of claims 1-13 under 35 U.S.C. §102(b) be withdrawn.

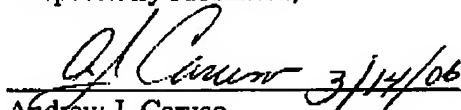
New claims 29-32 have been added. Support for the new claims 29-32 can be found, among other places, in paragraph [0003] of the instant specification. Support for claim 32 can be found, among other places, in paragraph [0031], which specifically describes orthogonally configured component films.

The Applicants respectfully submit that as claims 29-32 are dependent on claim 1, which is in condition for allowance for reasons discussed above, claims 29-32 are not anticipated by McGrath, and hence are in condition for allowance.

In view of the foregoing, the Applicants respectfully submit that the application is now in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the examiner believe that anything further is needed to place the application in even better condition for allowance, the Examiner is requested to contact the Applicants' undersigned representative at the telephone number below.

Respectfully submitted,


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